

REMARKS

Upon entry of this Amendment, claims 1-9 and 11-21 remain pending, with claims 1-4, 19, and 20 withdrawn from consideration, and claims 5-9, 11-18, and 21 under current examination.

Regarding the Office Action:

In the Office Action,¹ the Examiner took the following actions:

- (a) objected to claims 5, 9, and 10 because of informalities;
- (b) rejected claims 11-14, 17, and 18 under 35 U.S.C. § 112, second paragraph, as being indefinite;
- (c) rejected claims 5-7 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,543,107 ("Miyashita");
- (d) rejected claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Miyashita and U.S. Patent No. 5,043,049 ("Takenaka");
- (e) rejected claims 15-18 under 35 U.S.C. § 103(a) as being unpatentable over Miyashita and U.S. Patent No. 6,608,383 ("Yokoyama");
- (f) rejected claims 11 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Miyashita, Yokoyama, and U.S. Patent No. 5,817,532 ("Joo");
- (g) objected to claim 10 as being dependent upon a rejected base claim, but indicated that it would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims; and
- (h) indicated that claims 12 and 14 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, 2nd paragraph, and to include all of the limitations of the base claim and any intervening claims.

Applicant traverses the objections and rejections for the following reasons.

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

Objection to Claims 5, 9, and 10:

Applicant has amended claims 5 and 9 to provide proper antecedent basis for the terms the Examiner identified. Further, Applicant has incorporated the subject matter of now-cancelled (and allowable) claim 10 into claim 5, and provided proper antecedent basis for the recitations of claim 10 as they now appear in claim 5. These amendments overcome the objection to these claims. Applicants therefore respectfully request its withdrawal.

Rejection of Claims 11-14, 17, and 18 under 35 U.S.C. § 112, 2nd ¶:

Applicant has amended claims 11 and 17 to clarify that the claimed film has “a higher ~~erystal~~ crystalline orientation” (claim 11) and “a ~~erystal~~ crystalline orientation characteristic lower than that of the ground film” (claim 17). Applicant submits that the X-ray diffraction peaks and the crystalline orientations as indicated by Miller indices discussed throughout the specification more than clearly support the use of these claim terms.

The claims therefore fully comply with the provisions of 35 U.S.C. § 112, 2nd paragraph, and meet the threshold requirements of clarity and precision. Applicant therefore respectfully requests withdrawal of this rejection. If, after consideration of the amendments presented herein, the Examiner still has any concerns about the clarity of Applicant’s claim language, Applicant respectfully requests that the Examiner telephone the undersigned representative to discuss the claim language.

Rejection of Claims 5-7 under 35 U.S.C. § 102(e):

Applicant requests reconsideration and withdrawal of the rejection of claims 5-7 under 35 U.S.C. § 102(e) as being anticipated by Miyashita. Applicant has incorporated the subject matter of now-cancelled (and allowable) claim 10 into independent claim 5, thereby overcoming this rejection. Independent claim 5 should therefore be allowable, as should its dependent claims 6 and 7. Accordingly, Applicant requests withdrawal of the 35 U.S.C. § 102(e) rejection.

Remaining 35 U.S.C. § 103(a) Rejections of Claims 8, 9, 11, 13, and 15-18:

Applicant requests reconsideration and withdrawal of the remaining 35 U.S.C. § 103(a) rejections of claims 8, 9, 11, 13, and 15-18. Applicant has incorporated the subject matter of now-cancelled (and allowable) claim 10 into independent claim 5, thereby rendering claim 5 allowable. Dependent claims 8, 9, 11, 13, and 15-18 should therefore also be allowable at least by virtue of their dependence from base claim 5. Accordingly, Applicant requests withdrawal of the remaining 35 U.S.C. § 103(a) rejections.

Allowable Claims 10, 12, and 14:

Applicant acknowledges with appreciation the Examiner's indication of allowable subject matter in claims 10, 12, and 14. For the reasoning presented above, including the explanation of the amendments made, all the pending claims are in condition for allowance.

New Claim 21:

New claim 21, while of different scope, contains recitations similar to those in claims 5 and 7, and should also be allowable for the reasons already discussed. In addition, new claim 21 recites "forming a second amorphous insulation film made of an ABO_3 perovskite type oxide dielectric on the first amorphous insulation film, the second amorphous insulation film having higher oxygen content than that of the first amorphous film." Such a structure is not disclosed or suggested by the cited references.

Conclusion:

In view of the foregoing, Applicant requests reconsideration of the application and withdrawal of the objections and rejections. Pending claims 5-9, 11-18, and 21 are in condition for allowance, and Applicant requests a favorable action.

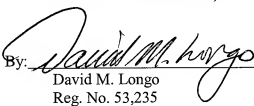
If there are any remaining issues or misunderstandings, Applicant requests the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 2, 2008

By: 
David M. Longo
Reg. No. 53,235

/direct telephone: (571) 203-2763/